



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/784,629

02/23/2004

Joseph P. Errico

F-273

8400

530 7590 07/30/2007  
LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD, NJ 07090

EXAMINER

WOODALL, NICHOLAS W

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

07/30/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/784,629

Applicant(s)

ERRICO ET AL.

Examiner

Nicholas Woodall

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13 and 15-20 is/are rejected.
- 7) ☒ Claim(s) 11, 12 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on 04/26/2007.

#### ***Allowable Subject Matter***

2. The indicated allowability of claims 6-8, 10, and 17 is withdrawn in view of the newly discovered reference(s) to Keller. Rejections based on the newly cited reference(s) follow.

#### ***Claim Objections***

3. Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 requires both prongs include a prong extension. Claim 15 requires only that at least one of the prongs include a prong extension and is therefore broader in scope and does not further limit the subject matter of claim 1.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 13 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. Claim 13 appears to add a second longitudinal bore to the device. The examiner cannot find a description of figures disclosing an embodiment of the invention having two sleeve bores along the longitudinal axis.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There exists an inconsistency between the language of claim 1 and that of the claim 16 dependent thereon, thus making the scope of the claim unclear. In the preamble of claim 1, line 1, applicant recites "An apparatus" with the preparation device being only functionally recited, i.e. "for manipulating a preparation device....", thus indicating that the claim is directed to the subcombination, "An apparatus". However, in claim 16, lines 1-3, applicant positively recites the preparation device as part of the invention, i.e. "wherein the preparation device includes a recess forming an annular groove having a width.", thus indicating that the combination, apparatus and preparation device, is being claimed. As such, it is unclear whether applicant intends to claim the subcombination or combination. Applicant is hereby required to indicate to which, combination or subcombination, the claims are intended to be directed, and amend the claim such that the language thereof is consistent with this intent. For examination purposes claims 1-20 will be considered as being drawn to the subcombination, apparatus.

***Drawings***

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least one plunger and at least one recess cooperating with the plunger (claims 10-12) and at least one sleeve bore through a longitudinal sleeve axis of the sleeve having a sleeve bore width that is greater than a sleeve bore depth (claim 13) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Claim 13 appears to add a second longitudinal bore to the device. The examiner cannot find a description of figures disclosing an embodiment of the invention having two sleeve bores along the longitudinal axis.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheets should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-10 and 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Keller (U.S. Patent 4,997,432).

Regarding claim 1, Keller discloses a device comprising an extension having a longitudinal axis, at least two prongs connected to a fulcrum at a distal end of the extension and a sleeve collinear with the longitudinal axis of the extension and surrounds at least a portion of the distal end of the extension including the fulcrum and at least portion of the two prongs. Each prong includes a prong extension that defines a contractable and expandable holding enclosure. The sleeve includes a bore that extends along the longitudinal axis of the extension, wherein the bore defines a cross-section having a width that is greater than a depth. Regarding claim 2, Keller discloses a device wherein the device is capable of manipulating a preparation device by at least one of holding, inserting, repositioning, removing, impacting, and extracting. Regarding claim 3, Keller discloses a device further comprising a handle having a distal end coupled to a proximal end of the extension. Regarding claim 4, Keller discloses a device further comprising a flange the facilitates the rotation of the sleeve. Regarding claim 5,

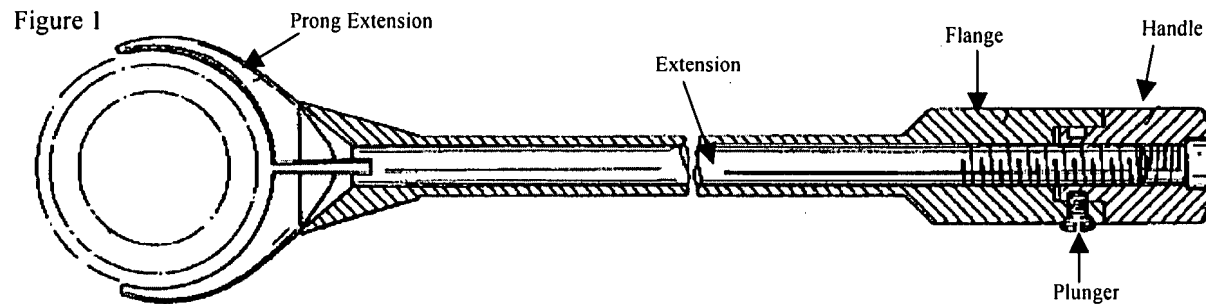
Keller discloses a device wherein the holding enclosure is cylindrical. Regarding claim 6, Keller discloses a device wherein a first of the prongs is spring-loaded with respect to a second of the prongs to bias the holding enclosure to a receptive state in which the first prong and the second prong are separated by a receptive state distance that does not allow a desired engagement diameter of the preparation device to pass between a distal end of the first prong and a distal end of the second prong without altering a portion of at least one of the prongs, wherein a manual pushing of the preparation device in a proximal direction along the extension longitudinal axis between the distal end of the first prong and the distal end of the second prong brings the holding enclosure to an expanded state wherein the distal ends of the prongs are separated by an expanded state distance that allow the desired engagement diameter of the preparation device to completely pass between the prongs, wherein rotation of the sleeve about the extension longitudinal axis brings an inner surface of the sleeve to bear on at least one of the prongs to move the holding enclosure to a contracted state in which the holding enclosure cannot be brought to the expanded state. The examiner believes that the sleeve of the device is capable of being rotated while being longitudinally displaced to perform the functional limitations of claim 6. Regarding claim 7, Keller discloses a device wherein the spring-loading of the prongs relative to one another is effected by at least one of a dimension of at least one of the prongs or a material strength of at least one of the prongs. Regarding claim 8, Keller discloses a device wherein the distal extension ends are tapered more narrowly toward the holding enclosure to facilitate passage of the preparation device. Regarding claim 9, Keller

discloses a device wherein the sleeve is biased toward stopping its rotation at desired positions. Regarding claim 10, Keller discloses a device wherein the biasing is effected by at least one plunger and at least one recess cooperating with the plunger at the desired position. Regarding claim 15, Keller discloses a device wherein at least one of the prongs terminates in at least one prong extension. Regarding claim 16, Keller discloses a device wherein the at least one prong extensions is capable of having a thickness less than a width of an annular groove of a preparation device. Regarding claim 17, Keller discloses a device wherein the at least one prong extension widens outwardly. Regarding claim 18, Keller discloses a device wherein the at least one prong extension is rigid. Regarding claim 19, Keller discloses a device wherein the at least one prong extension includes a first semicircular extension having a first inwardly facing surface and a second semicircular extension having a second inwardly facing surface that faces the first inwardly facing surface such that the first and second inwardly facing surfaces form the holding enclosure. Regarding claim 20, Keller discloses a device wherein the rotation of the sleeve contracts and expands the first and second inwardly facing surfaces relative to each other. Regarding the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Keller, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218



Art Unit: 3733

USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).



### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. The examiner has presented new grounds of rejection as discussed above that were not necessitated by amendment making this office action non-final.

### ***Allowable Subject Matter***

12. Claims 11, 12, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

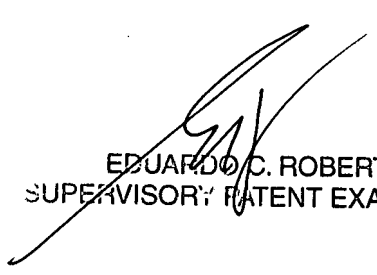
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER